

with traverse of Group II on November 10, 1999. The Examiner states that the traversal is on the ground(s) that no generic claims were previously identified.

Allowable Subject Matter

Applicant notes with appreciation the Examiner indicated that Claims 6-7, 26, 33 and 35 define patentable subject matter over the art of record. As the base claims from which these claims depend have been amended and are now in condition for allowance, favorable consideration and allowance of Claims 6-7, 26 and 33 is respectfully solicited.

Objection to the Drawings

The drawings have been objected to as not including a reference designation mentioned in the description, as having an incorrect reference designation and for failing to show every feature of the invention specified in the Claims.

In response, Applicant notes that designation 166 is included in Figure 9. However, revised drawing sheets for Figures 8 and 9 are submitted herewith to correct an incorrect designation of "164" and "170" in Figure 8 and "156" in Figure 9. These now read --166-- and --164-- and --256-- respectively as shown in red on the enclosed Figures 8 and 9. Approval of the amendments to the drawings is respectfully solicited.

With respect to the element of a "hinge" as used in pending Claim 33, the Examiner is directed to the specification, page 28, lines 1-5, referring to reference designation 540 in Figure 15 as a "releasable hinge." Therefore, it is submitted that this element of the claims is properly supported by the current drawings.

With respect to the element "plurality of support posts coupled to the guardrail" it is noted that this element is inherent to Applicant's disclosure and is readily supported by the disclosure and pending claims. However, to overcome the objection to the drawings, and

unrelated to the patentability of the claims with respect to the sufficiency of the disclosure or the content of the prior art, Claims 34 and 35 have been canceled, without prejudice or disclaimer

Objections to the Specification

In response to the objection to the Abstract, Applicant submits herewith a substitute abstract for consideration and approval by the Examiner.

The specification has been objected to as allegedly failing to provide proper antecedent basis for the Claimed subject matter. Claim 32 has been amended to attend to the objection with respect to the term "flanges." The specification has been amended to provide a positive recitation of the term "extensions" as used in Claim 33. This language is clearly supported by the original disclosure and drawings, see *inter alia* Figure 15, and does not introduce new matter. Claims 34 and 35 have been canceled to attend to the objection to the drawings, thereby obviating the objections with respect to these claims.

Objection to the Claims

Claim 8 has been amended to attend to a noted informality in the claim with respect to an unnecessary recitation of the term "the guardrail".

Claim Rejections- 35 U.S.C. § 112

Claims 5-9, 24-26, 28-30 and 32-35 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite.

Claims 5, 8, 9, 10, 24, 25, 28, 32, 33 have been amended to clarify the language cited in the Office Action as rendering the claims indefinite, thereby overcoming the present rejections. Claims 30, 34 and 35 have been canceled, thereby obviating the rejection to such claims.

Claim Rejections- 35 U.S.C. § 102

Claims 5, 8-9, 28 and 30 stand rejected as allegedly being anticipated by Gray. It is noted that U.S. Patent No 3,417,965 and U.S. Patent 3,332,666, both of which are to Gray, are of record in the present application. Based on the references in the Office Action, Applicant believes that the rejection is based on the '666 patent and traverses accordingly.

The '666 patent is directed to a guard rail assembly which includes a lower portion and an inclined upper portion rotatably coupled thereto by a pin. An elastic member is provided to maintain the upper portion in an inclined relationship with the lower portion until presented with a rail face impact. Upon such an impact, the upper portion rotates about the pin under the resistance of the elastic member. This provides compliance and absorption of rail face impact forces. The lower portion is generally U-shaped in cross section and provides substantial support to the upper portion in a direction along the axis defined by the rail face. Thus, the '666 patent discloses a structure which provides substantial resistance to failure to a rail end impact.

Independent Claims 5, 9 and 28 are directed to support posts which are designed to resist a rail face impact yet yield to a rail end impact. This solves a substantial problem in the art where the guardrail system, which is intended to protect against hazzards, in fact can become a new hazzard in the event of a rail end impact. This is exemplified in the specification on page 1, lines 2-18 and page 13, lines 12-32.

The '666 patent does not disclose a support post which resists a rail face impact and yields to a rail end impact. In fact, the '666 patent discloses just the opposite. The structure recited in the '666 patent yields in the presence of a rail face impact, as the upper portion on which the guardrail is mounted rotates with increasing resistance in the presence of a rail face impact. Further, the structure disclosed in the '666 patent provides maximum resistance in the direction of a force imparted in a rail end impact. Claim 28 as amended calls for various features including "a Frangible connection ..." which is neither shown nor taught by the '666 patent.

Therefore, the '666 patent does not anticipate Claims 5, 9 or 28. Applicant requests withdrawal of the rejection and allowance of Claims 5, 9 and 28 as amended.

Claim 8 depends from Claim 5 and is allowable over the '666 patent at least by virtue of this dependency.

Claims 10, 11 and 12 are dependent directly or indirectly from Claim 9. Since Claim 9 as amended is now deemed allowable, Applicant requests that the Examiner withdraw the restriction requirement concerning Claim 10, 11 and 12 and allow Claims 10, 11 and 12 as amended.

Claim 31 depends from Claim 28. Since Claim 28 as amended is now deemed allowable, Applicant requests withdrawal of the restriction requirement and allowance of Claim 31.

Claim Rejections- 35 U.S.C. § 103

Claims 24-25, 32 and 34 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Gray in view of U.S. Patent No. 2,309,238 to Corey.

Claims 24 and 32 recite a pivot pin that extends in a strong direction which is substantially perpendicular to the guardrail and a shearable member which provides limited resistance to rotation about the pivot pin. As with Claim 5, discussed above, this arrangement resists a rail face impact while yielding to a rail end impact.

As noted above, the '666 patent does not disclose, and in fact teaches away from, a guardrail configuration which resists a rail face impact while yielding to an rail end impact. In view of this teaching away in the primary reference, any combination with the '666 patent is improper. Further, the '238 patent does not cure the noted deficiency of the '666 patent. The '238 patent is directed to a valve stem for a fire hydrant which is designed to fail regardless of the direction of impact. It does not teach or suggest a strong impact axis and a weak impact axis and does not provide any teaching to modify the '666 patent to arrive at the invention set forth in

Claims 24 and 32. Therefore, a prima facie showing of obviousness cannot be sustained and allowance of Claims 24 and 32 is respectfully solicited.

Claim 25 depends from Claim 24 and is allowable at least by virtue of this dependency.

Claim 27 depends from Claim 24. Since Claim 24 as amended is now deemed allowable, Applicant requests withdrawal of restriction requirement and allowance of Claim 27.

Claim 29 has been amended to independent form. Applicant requests that the Examiner reconsider Claim 29 as amended and withdraw the restriction requirement.

Claim 34 was canceled in view of informalities with respect to the drawing as set forth above.

Conclusion

Applicant has now made an earnest effort to place this case in condition for examination and allowance in light of the amendments and remarks set forth above. Applicant respectfully requests reconsideration of the application and allowance of Claims 5-10, 24, 25, 28, 32, and 33 as amended.

A check in the amount of \$110.00 for one month extension fee is enclosed. Applicant does not believe there are any additional fees due at this time. However, the Commissioner is hereby authorized to charge any additional fees (including any extension fees) or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

ATTORNEY DOCKET NO.
091078.0554

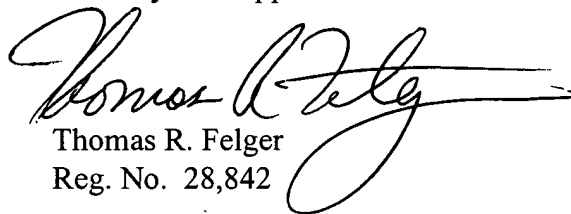
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If there are matters which can be discussed by telephone to further the prosecution of this application, Applicant respectfully requests that the Examiner call their attorney at the number listed below.

Respectfully submitted,

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Enclosures: Revised informal drawings for FIGURES 8 and 9 and
Notification of Extension of Time Under 37 C.F.R. § 1.136 with appropriate
filing fee

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